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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/084,421	02/28/2002	Hiroshi Matsuda	03500.016241	7453

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EXAMINER

RUDOLPH, VINCENT M

ART UNIT PAPER NUMBER

2624

DATE MAILED: 10/04/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/084,421

Applicant(s)

MATSUDA, HIROSHI

Examiner

Vincent Rudolph

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 28 February 2002.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-28 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-28 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 28 February 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 17-20 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The control program claimed is merely a set of instructions per se. Since the control program is merely a set of instructions not embodied on a computer readable medium to realize the software architecture functionality, the claimed subject matter is non-statutory. See MPEP § 2106 IV.B.1.

### ***Claim Rejections - 35 USC § 112***

Claims 1-8 and 21-28 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Regarding claims 1-4 and 21-24, when defining "said device" in the preamble, it unclear whether that is referring to an image processing device or an information processing device.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chan ('070).

Regarding claim 1, Chan ('070) discloses an image processing device, which is a secure printer (See Figure 1, Element 140), that can be connected to an information processing device, or a local computer (See Figure 1, Element 100). This device has an authentication processing means (directory server receiving the information prior to processing a key for the intended recipient, Col. 6, Line 7-12), which is done in response to a request from the information processing device (See Col. 5, Line 66-Col. 6, Line 4), for performing the authenticating process according to the request made from the information processing device. The device also includes a display, generated onto a graphical user interface (See Col. 6, Line 4-5) with information transmission means (a network such as a LAN) for transmitting the screen contents for operating the information processing device by supplying information, such as document details, about the image processing device when a request is authenticated and recognized (See Col. 6, Line 2-14). The device has a second authentication processing means with an authenticating step by reading information stored on a card, such as a smart card (See Figure 1, Element 145), which is inserted into the image processing device (See Col. 6, Line 58-67). By doing this, a request from an operation unit, such as the CPU (See Figure 2, Element 200), within the image processing device is recognized based on the authentication result, and thus the image processing device is operable (See Col. 7, Line 1-20).

Chan ('070) does not disclose transmitting the information from the image processing device to the information processing device.

It would have been obvious to one of ordinary skill in the art at the time of the invention by the applicant to include transmitting information, such as a message on the display of the information processing device to inform the user the document was printed. By doing this, the user is better able to verify the genuine recipient of the document, i.e. if the intended recipient is away from the office and the sender is notified that the document was printed, the sender would be able to identify a security breach.

Regarding claim 2, Chan ('070) discloses an image processing device, which is a secure printer (See Figure 1, Element 140), that can be connected to an information processing device, or a local computer (See Figure 1, Element 100). This device has a first authentication input means (the sender entering the document details and identity of the recipient), which is done in response to a request from the information processing device, for inputting the requested authentication information from the information processing device (See Col. 6, Line 2-14). A second authentication input means is performed for inputting authentication information input from an operation unit, such as a smart card (See Figure 1, Element 145), which is inserted into the image processing device (See Col. 6, Line 58-63). This device has an authentication processing means (smart card reader of the secure printer; See Col. 6, Line 58-61), which is done in response to a request from the information processing device (See Col. 5, Line 66-Col. 6, Line 4), for performing the authenticating process according to the request made from the information processing device. The device also includes a display, generated onto

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a graphical user interface (See Col. 6, Line 4-5) with information transmission means (a network such as a LAN) for transmitting the screen contents for operating the information processing device by supplying information, such as document details, about the image processing device when a request is authenticated and recognized (See Col. 6, Line 2-14). Whenever an operation within the operation unit or a request from the information processing device does not happen to match the operation being performed in the image processing device, the operation or request is accepted regardless based on the authentication processing means result, such as accepting the job, informing the user the number of documents awaiting (See Col. 7, Line 1-20), and placing it in the proper order to print (See Col. 7, Line 50-51).

Chan ('070) does not disclose transmitting the information from the image processing device to the information processing device.

It would have been obvious to one of ordinary skill in the art at the time of the invention by the applicant to include transmitting information, such as a message on the display of the information processing device to inform the user the document was printed. By doing this, the user is better able to verify the genuine recipient of the document, i.e. if the intended recipient is away from the office and the sender is notified that the document was printed, the sender would be able to identify a security breach.

Regarding claim 3, Chan ('070) discloses an image processing device, which is a secure printer (See Figure 1, Element 140), that can be connected to an information processing device, or a local computer (See Figure 1, Element 100). This device has an authentication processing means (smart card reader of the secure printer; See Col.

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6, Line 58-61), which is done in response to a request from the information processing device (See Col. 5, Line 66-Col. 6, Line 4), for performing the authenticating process according to the request made from the information processing device. The device also includes a display, generated onto a graphical user interface (See Col. 6, Line 4-5) with information transmission means (a network such as a LAN) for transmitting the screen contents for operating the information processing device by supplying information, such as document details, about the image processing device when a request is authenticated and recognized (See Col. 6, Line 2-14). The device has a second authentication processing means with an authenticating step by inputting information stored on a card, such as a smart card (See Figure 1, Element 145), which is inserted into the image processing device (See Col. 6, Line 58-67). Whenever a request from the operation unit is accepted based on the authentication result by the second authentication processing means, the request to operate the image processing device from the information processing device is not accepted, since the user has to verify the document information at the printer prior to printing (See Col. 7, Line 1-20).

Chan ('070) does not disclose transmitting the information from the image processing device to the information processing device.

It would have been obvious to one of ordinary skill in the art at the time of the invention by the applicant to include transmitting information, such as a message on the display of the information processing device to inform the user the document was printed. By doing this, the user is better able to verify the genuine recipient of the

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document, i.e. if the intended recipient is away from the office and the sender is notified that the document was printed, the sender would be able to identify a security breach.

Regarding claim 4, Chan ('070) discloses an image processing device, which is a secure printer (See Figure 1, Element 140), that can be connected to an information processing device, or a local computer (See Figure 1, Element 100). This device has an authentication processing means (smart card reader of the secure printer; See Col. 6, Line 58-61), which is done in response to a request from the information processing device (See Col. 5, Line 66-Col. 6, Line 4), for performing the authenticating process according to the request made from the information processing device. The device also includes a display, generated onto a graphical user interface (See Col. 6, Line 4-5) with information transmission means (a network such as a LAN) for transmitting the screen contents for operating the information processing device by supplying information, such as document details, about the image processing device when a request is authenticated and recognized (See Col. 6, Line 2-14). The device has a second authentication processing means with an authenticating step by reading information stored on a card, such as a smart card (See Figure 1, Element 145), which is inserted into the image processing device (See Col. 6, Line 58-67). Whenever a request from the operation unit is accepted based on the authentication result by the authentication processing means, the request to operate the image processing device from the information processing device is not accepted, since the user has to verify the document information at the printer prior to printing (See Col. 7, Line 1-20).



Chan ('070) does not disclose transmitting the information from the image processing device to the information processing device.

It would have been obvious to one of ordinary skill in the art at the time of the invention by the applicant to include transmitting information, such as a message on the display of the information processing device to inform the user the document was printed. By doing this, the user is better able to verify the genuine recipient of the document, i.e. if the intended recipient is away from the office and the sender is notified that the document was printed, the sender would be able to identify a security breach.

Regarding claim 5, Chan ('070) discloses the authentication and second authentication processing means perform an authenticating process on the same authentication information, which is the recipient's identity, as set within the image processing device, so it can verify this is the same user that wishes to print out the requested document (See Col. 7, Line 1-20).

Regarding claim 6, Chan ('070) discloses an identification information means (a computer when entering a request, Col. 5, Line 66-Col. 7, Line 7) for issuing identification information (the sender's information, Col. 6, Line 5-7) to the processing device (the local computer, Figure 1, Element 100) when a request from the information processing device is recognized (the user submits a document to be printed, Col. 5, Line 66-Col. 6, Line 2) based on the authentication result (smart card is correctly identified to the intended user, Col. 7, Line 1-7) by the authentication processing means (smart card reader of the secure printer; See Col. 6, Line 58-61). There is also a determination means (the directory server, Figure 1, Element 120) for determining, in

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response to a request from the information processing device, that the identification information transmitted is added to the request (See Col. 6, Line 4-14). Whenever the determination means determines the identification information is added, the display information transmits the display information with an authenticating process since the requested information is already sent and this information is to verify the intended recipient (See Col. 6, Line 2-14).

Chan ('070) does not disclose transmitting the identification information from the image processing device to the information processing device.

It would have been obvious to one of ordinary skill in the art at the time of the invention by the applicant to include transmitting information, such as a message on the display of the information processing device to inform the user the document was printed. By doing this, the user is better able to verify the genuine recipient of the document, i.e. if the intended recipient is away from the office and the sender is notified that the document was printed, the sender would be able to identify a security breach.

Regarding claim 7, Chan ('070) discloses the display information can be accessed via the Internet so a user could modify the profile if one wishes to receive documents from one specified printer (See Col. 8, Line 17-29) and the request from the information processing device and the display information are transmitted and received through a network so the information is transmitted to the printer through a protocol (See Col. 7, Line 55-62).

Chan ('070) does not disclose the display information is described in an HTML document as well as transmitted and received according to an HTTP protocol.

It would have been obvious to one of ordinary skill in the art at the time of the invention by the applicant to have the information, when accessed by the Internet, in an HTML document since the majority of information provided over the Internet is viewed as an HTML document and most computers include a browser capable of displaying a HTML document. Also, since information is sent across a network, an HTTP protocol is needed, such as an IP address, to properly transmit and receive the requested information.

Regarding claim 8, Chan ('070) discloses a conversion means for converting the request for authentication input by the first and second authentication input means into a format, such as a session key for the first (See Col. 6, Line 35-40) and second (See Col. 7, Line 30-37) authentication, interpretable by the authentication processing means so the key is decrypted (See Col. 7, Line 30-37) and the document can be printed (See Col. 7, Line 41-50).

Regarding claims 9-16 and 21-28, the rationale provided in the rejection of claims 1-8 is incorporated herein respectively. In addition, the device of claims 1-8 corresponds to the method and device of claims 9-16 and 21-28 and performs the steps disclosed, respectively.

Regarding claim 17-20, the rationale provided in the rejection of claims 1-4 is incorporated herein. In addition, the device of claims 1-4 corresponds to the control program (See Col. 3, Line 27-30) of claims 17-20 and performs the steps disclosed, respectively.

**Conclusion**

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure is: Davis ('932) and Hertling ('741).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Vincent Rudolph whose telephone number is (571) 272-8243. The examiner can normally be reached on Monday through Friday 8 A.M. - 4:30 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Moore can be reached on (571) 272-7437. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Vincent Rudolph  
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